

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

88265-74701

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Application Number

10/797,373

Filed

March 9, 2004

First Named Inventor

Alain Leas

Art Unit

1761

Examiner

Viren A. Thakur

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record.
Registration number 30,256☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

Allan A. Fanucci

Typed or printed name

212-294-3311

Telephone number

October 28, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Alain LEAS et al.

Confirmation No.: 4476

Application No.: 10/797,373

Group Art Unit: 1761

Filing Date: March 9, 2004

Examiner: Viren A. Thakur

For: PACKAGED DECORATED FROZEN
CONFECTION AND METHOD OF
MANUFACTURE

Attorney Docket No.: 88265-74701

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF

Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

Sir:

Applicants request a panel review of the decision of the Examiner mailed April 29, 2008, rejecting claims 1-4, 8-10 and 25-37 under 35 U.S.C. § 103(a).

I. The Examiner Failed to Articulate a *Prima Facie* Case of Obviousness Under 35 U.S.C. § 103(a)

a. Claims 1-4, 8, 10, 25-28, and 30-33 are not obvious over the combination of Krein, D'Amato and Kuehl

Claims 1-4, 8, 10, 25-28, and 30-33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 2,106,893 to Krein ("Krein") in view of EP 0276333 to D'Amato (D'Amato) and EP 0848910 A2 to Kuehl et al. ("Kuehl").¹

As previously explained in Applicants' October 21, 2008 response,² there is absolutely no motivation to combine the teachings of Krein and D'Amato to render obvious claims 1-4, 8, 10, 25-28 and 30-33, as these claims are in no way taught or suggested in the disclosure of these references, singly or taken in combination. The Examiner cites D'Amato as teaching transparent plastic packaging, arguing that it would have been obvious to combine

¹ See September 25, 2007 Office Action, pp. 3-8 for a detailed explanation of the Examiner's rejection.

² See pp. 4-7; see also Applicants' January 22, 2008 Response, pp. 9-10.

D'Amato's plastic packaging with Krein's chocolate cone, resulting in the present invention.³ While Krein acknowledges the attractive two-toned effect of the chocolate and ice-cream combination, it is clear that his disclosure is primarily concerned with creating an economical method of making a frozen confectionary package, which is not cost-prohibitive when applied to mass production. Specifically, Krein states that individual manufacture and production of confection packages is "so *expensive* (emphasis added) and laborious as not to be feasible, in most case, for commercial manufacture." (See Krein, p. 1, lines 18-21).⁴

The Examiner's assertion that Krein's recognition of the visual effect of his cone teaches motivation for combination with D'Amato is unsupported, as Krein chose an opaque material, *i.e.*, paper, for his packaging, as opposed to a transparent one.⁵ Plastic packaging materials were readily available at the time of Krein's invention, and yet he consciously opted to use a non-transparent paper package, as his primary concern was to minimize production costs, as opposed to allowing consumers to view the product through its packaging.⁶

Further, and as previously explained,⁷ all references to Krein's two-toned confection disclose that the visual effect may only be observed after stripping away the packaging. There is no disclosure or suggestion in Krein that it is desirable for the consumer to be able to view the confection or its attractive visual effect directly through the packaging. If this were indeed a concern for Krein, he would have opted for a transparent packaging material.⁸ Instead, Krein expressly took into consideration the fact that the material used should be easily stripped away from the chocolate prior to consumption.⁹ As far as Krein was concerned, any attractive visual effect would accordingly only be viewable upon removing the packaging. This is why Krein uses a paper sleeve rather than a plastic sleeve which would allow the consumer to see the product. Furthermore, the present use of a plastic sleeve as a mold for forming the shell of the cone contributes to a smooth outer surface of the shell.

³ See September 25, 2007 Office Action, p. 3-5.

⁴ See also Krein, p. 1, lines 21-23 (teaching with regard to commercial manufacture of confections, that "simplicity, ease of handling, and economy are very highly desirable, if not essential") and lines 25-30 ("it has not as yet been possible to line a wrapper of paper, for example, with chocolate, and freeze a confection ... with sufficient facility and economy to warrant commercial production...").

⁵ See Leas Declaration, para. 11.

⁶ See Leas Declaration, para. 19.

⁷ See Applicants' January 22, 2008 Response, p. 9.

⁸ See Leas Declaration, para. 19.

⁹ See Krein, p. 2, lines 27-31 ("[T]he container being preferably of a dry wax or wax coated paper, the adhesion of the chocolate to the container is not such that will prevent an easy stripping of the container from the chocolate.").

D'Amato is cited to remedy the deficiencies of Krein, but does not do so. D'Amato discloses a loose-fitting plastic container, such that there is no complete surface to surface contact with the shell, within which the shell is formed with a smooth exterior. Instead, D'Amato's loose fitting container is intended to not closely contact the shell to facilitate removal of the confection from the package. D'Amato's confection is not prefabricated in the packaging, and there is no indication that his packaging is even suitable as a mold for manufacture of a shell therein. Rather, D'Amato's confectionary product is placed in the packaging after manufacture, and the packaging is optimally designed to cushion and absorb shocks from transportation and handling, to provide insulation from premature melting and to facilitate removal therefrom.

Further, the disclosures of D'Amato and Krein teach away from each other. As explained during prosecution,¹⁰ Krein was primarily concerned with providing an economical alternative to more expensive materials, such as plastic, in the manufacture of an ice cream packaging which is clearly intended to be stripped away prior to consumption. D'Amato, however, was primarily concerned with designing a means by which ice cream packages may be transported and handled without damage, and does not remedy the deficiencies of Krein. "A prior art reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Accordingly, a person skilled in the art would not be motivated by the disclosure in D'Amato which teaches a loose-fitting plastic container for handling ice cream packages without damage thereto, to modify an economical paper package in which the confectionary product is manufactured, to result in the present invention.

Both the Federal Circuit and the MPEP clearly explain that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.¹¹ Any modification of Krein by adding D'Amato's more expensive plastic packaging would defeat Krein's central purpose of providing an economical packaging for housing a confection, which is intended to be stripped prior to consumption. Accordingly, the combination of Krein and D'Amato is insufficient and improper in establishing a *prima facie* case of obviousness.

¹⁰ See Applicants' January 22, 2008 Response, p. 10.

¹¹ See *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984); MPEP 2143.01(V).

As previously explained,¹² Kuehl also is incompatible with Krein and D'Amato as its primary purpose is to impart an attractive appearance to its confectionary product, and it does not disclose a sleeve that corresponds to the shape of the confectionary shell and which is in contiguous surface to surface contact therewith, or maintenance of a smooth outer shell.¹³ Also, Kuehl's confection is prefabricated prior to being placed in its packaging. Kuehl further makes no mention of any economical concerns in developing his confectionary product, nor does he disclose an appreciation for the need to protect his confectionary products from damage during transportation and handling. Accordingly, there is no unifying motivation or theme amongst the three references that the Examiner has improperly sought to combine, simply because they all relate to confectionary products. It is clear that the Examiner obviousness objection is based upon improper hindsight reasoning using the Applicants' application as a guide, and consequently should be withdrawn.

b. Newsteder, Palmer and Phillips Fail to Remedy the Deficiencies of Krein, Kuehl and D'Amato, to Render Obvious Claims 9, 29 and 34-37

Claims 9, 29 and 34-37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Krein in view of D'Amato and Kuehl, and further in view of U.S. Patent No. 4,778,683 to Newsteder ("Newsteder"), U.S. Publication No. 20030099746 A1 to Palmer ("Palmer"), and U.S. Patent No. 5,035,907 to Phillips et al. ("Phillips").¹⁴ These additional references are summarized in Applicants' Response of October 21, 2008 (*see* pp. 9-14). While the Examiner concedes that the combination of Krein, Kuehl and D'Amato does not teach a decorative pattern design including a writing, script, logo or symbol as required by rejected claims 9, 29 and 34-37, he cites Newsteder, Palmer and Phillips to show that it was conventional in the art to use symbols, logos and writing to impart design to food products.¹⁵

As previously argued,¹⁶ the combination of Newsteder, Palmer and Phillips does not remedy the deficiencies of Krein, Kuehl and D'Amato, to render claims 9, 29 and 34-37 obvious. The Examiner states that since Kuehl already discloses decorative patterns, that to change the pattern to a specific design such as a logo or writing is not a patentable distinction

¹² See Applicants' October 21, 2008 Response, pp. 7-8; Applicants' January 21, 2008 Response, pp. 10-12.

¹³ See *also* Leas Declaration, para. 7, 15-16.

¹⁴ See April 29, 2008 Final Office Action, pp. 3-4 for a detailed explanation of the Examiner's rejection.

¹⁵ See April 29, 2008 Final Office Action, p. 3, para.5.

¹⁶ See Applicants' October 21, 2008 Response, pp. 8-14.

over the prior art, since it was already known to impart writing or logos on products.¹⁷ Applicants disagree, as Kuehl does not disclose the advantages of providing writing or a logo in his process, and at best makes contrasting colors with strips, lines and dots. Further, Kuehl's designs are random and non-uniform (e.g. mottled, clouded, drizzled, splattered, speckled and flecked), and teach away from the sharp definition required to form a logo, writing, script or symbol, as presently claimed, and as contemplated in Newsteder, Palmer and Phillips.

There is no motivation to combine Newsteder with Kuehl, as Kuehl teaches a marbled confectionary coating for an ice cream product, while Newsteder focuses on chocolate bars. Newsteder teaches both a distinct visual separation, as well as physical separation between planes of the different colored chocolates, through the use of recessed molds.¹⁸ Further, Newsteder does not mention packaging, and his chocolate bars do not have a smooth outer surface as required by the shell in the present invention.

Additionally, the teachings of Palmer and Phillips do not have any reasonable unifying motivation with Kuehl, aside from being related to the general idea of food. Both Phillips and Palmer disclose manual application of text or design onto food. Such manual application of design onto food is conceptually distinct from, and unrelated to the mechanized application of random designs to an ice cream product. Moreover, neither reference discloses use or applicability of its invention in imparting design to ice confections. Accordingly, any combination of either reference with Kuehl is improper.

Based on the foregoing, it is presently submitted that the explanations provided herein, and as previously presented in the responses of October 21, 2008 and January 22, 2008, show that the position taken in the April 29, 2008 Final Office Action is incorrect and that the claims of the present application are allowable over the cited art.

Respectfully submitted,

10/28/08
Date

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¹⁷ See April 29, 2008 Final Office Action, p. 3, para.5.

¹⁸ See Newsteder, Col. 1, line 67-Col. 2, line 6 (disclosing "very fine detail" and "sharp color separation").